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OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314				CANTELMO, GREGG
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MANABU SUHARA,
KAZUO SUNAHARA,
NAOSHI SAITO and
TSUTOMU KATOH

Appeal 2006-2562
Application 10/089,109
Technology Center 1700

Decided: February 29, 2008

Before CHUNG K. PAK, PETER F. KRATZ, and CATHERINE Q. TIMM
Administrative Patent Judges.

PAK, *Administrative Patent Judge.*

DECISION ON REQUEST FOR REHEARING1

Pursuant to 37 C.F.R. § 41.52, Appellants request rehearing of our Decision entered November 16, 2006, directed to affirmance of the Examiner's rejections of claim 4 under 35 U.S.C. § 103(a) as unpatentable over the combined disclosures of either Toyoguchi or Masashi and Yamahira, and under the judicially-created doctrine of obviousness-type

double patenting as provisionally unpatentable over the claims of copending Application 10/296,205 in view of Yamahira. *See Request for Rehearing 1.*¹

The Appellants specifically contend for the first time that the volumetric packing density of 2.0 to 4.3 g/ml taught by Yamahira does not embrace the claimed packing press density of 2.90 to 3.35 g/cm³ since the claimed packing density is based on a measuring method different from that taught by Yamahira.² *Compare Request for Rehearing 1-4 with Br. 11-12.* The Appellants have not previously questioned the Examiner's specific finding that the packing density range of Yamahira is encompassed by the claimed packing press density range (Ans. 9-10; Reply Br. of Jun 7, 2006 in its entirety). The Appellants also for the first time in this appeal rely on a calculation to demonstrate that the differences in the measurement methods involved would result in different packing densities. Accordingly, we need not consider this newly proffered argument and the calculation accompanying it since "good cause" is not shown pursuant to 37 C.F.R. § 41.52(a)(1). *See Request for Rehearing 3-4.*

Even were we to consider it, we are not convinced that the Appellants have demonstrated that the lithium-cobalt composite oxide taught by Yamahira would not have a packing press density within the claimed packing press range. In this regard, we note that the Appellants have not provided any actual measurement of the packing press densities of Yamahira's products. *See In re De Blauwe, 736 F.2d 699, 705 (Fed. Cir.*

¹ The Request for Rehearing dated January 5, 2007.

² The term "cm³" is well known to one of ordinary skill in the art to represent a volume equal to or substantially equal to "ml."

1984) (Mere arguments in the Brief or conclusory statements in the Specification cannot take the place of objective evidence).

In any event, as pointed out at page 11 of our Decision, we find that Yamahira teaches a packing density as a result effective variable. As such, we correctly determine that the optimization of such variable is well within the ambit of one of ordinary skill in the art. *In re Boesch*, 617 F. 2d 272, 276 (CCPA 1980) (“[D]iscovery of an optimum value of a result effective variable in a known process is ordinarily within the skill of the art.”). The Appellants have not shown that the claimed packing densities produce unexpected results.

Accordingly, the Appellants’ Request for Rehearing is granted to the extent indicated above, BUT IS DENIED WITH RESPECT TO MAKING ANY CHANGES to our Decision.

REHEARING-DENIED

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